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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,037	07/29/2003	Richard Henry Parker	5601	9275

7590 07/20/2005  
John E. Vick, Jr.  
Legal Department, M-495  
PO Box 1926  
Spartanburg, SC 29304

EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/631,037

Applicant(s)

PARKER, RICHARD HENRY

Examiner

Marc S. Zimmer

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1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 10-20 and 22.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

*Marc Zimmer*  
Marc Zimmer  
TC 1700



### ***Response to Arguments***

In an attempt to illustrate that the scope of the claims is sufficiently enabled by the original disclosure, Applicant emphasizes that data concerning the cohesion parameters of a broad range of polymers is, in fact, readily available as evidenced by (i) the large number of hits returned when the phrase "polymer cohesion parameter" was inputted into the Google® search engine and (ii) the number of documents citing the work of Allan Barton who originally tabled the phrase and wrote of its significance in the *Handbook of Solubility Parameters and Other Cohesion Parameters*. (Applicant also cites MPEP 2164.08 which states, in part, that which is well known is best omitted [from the Specification describing one's invention].)

While the number of hits yielded by a Google® search of this term is impressive, the Examiner questions the relevance of these hits to the practitioner's endeavor of determining the cohesion parameter of specific materials. Indeed, the context in which this phrase is employed is not known for all but one of the sites that Applicant has mentioned. On the other hand, the Examiner acknowledges that the prior art citing the studies of Barton would likely be useful for ascertaining the cohesion parameter of some fraction of the total number of materials belonging to a particular genus.

The central concern that the Examiner continues to abide by is that, there is obviously some significant unpredictability associated with the cohesion parameters of related materials. Applicant states at the bottom of page 8 of their response (the third page of remarks) that "cohesion parameters for a given genus of polymers are predictably in a small range." How is it then that VAMAC D and Levapren 400, both of

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which are ethylene/methyl acrylate copolymers, are unsuitable as embodiments of the second polymer interdispersed with the silicone polymer, despite the fact that they belong to the same genus of polymers as does VAMAC 2036-1, which is a preferable embodiment of the second polymer in the instantly claimed invention? If there are examples of polymers that do, and do not, adhere to the cohesion parameter limitation set out by Applicant in every genus of polymer materials, how then is the practitioner of Applicant's invention to determine which ones are useful without measuring this property for each one individually?

Applicant seems to purport that, because there exist in the prior art teachings of the cohesion parameters of individual polymer materials that are readily available, the practitioner can, in connection with the alleged fact that all polymers of that genus will inherently have cohesion parameters similar to those reported by the prior art, readily select the polymers that are operable in their invention. The problem with this assertion is that Applicant's own observations regarding the unsuitability of VAMAC D and Levapren 400 contradict the premise that all members of a genus have similar cohesion parameters, thus rendering useless any available information pertaining to this topic useless if it is not specific to the polymer material of interest.

Applicant is advised that the claimed invention still seems to be allowable over the prior art for the reasons made of record in the correspondence dated October 16, 2004.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 15, 2005

*Marc Zimmer*  
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AU 1712